

Second Substitute Brief on Appeal

Application No. 10/613,946

The specific items required by 37 CFR 41.37 follow below:

(c)(i) Real Party of Interest

The real Party of interest in this application is the Inventor **Kevin T. Connolly**

(c)(ii) Related Appeals and Interferences

There are no related Appeals and Interferences

(c)(iii) (1) Status of the Claims

Claims 1, 4, and 9 - 11 and 16 are presently prosecuted in this application and are under a Final rejection.

Claims 2, 3, 5 - 8 and 12 - 15 are withdrawn subject to a restriction requirement

The examiner made a mistake by indicating on the cover sheet PTOL 326 that claim 16 is withdrawn while in fact claim 16 is pending in this application but the examiner refused to consider it in Par. 3 of the final rejection.

(c)(iv) (2) Status of Amendments

a) A Final Rejection was mailed on 06/08/2006.

b) Applicant answered the Final Rejection by way of remarks and arguments on 06/16/2006

c) The examiner responded to applicant's arguments by way of an Advisory Action which was mailed on 06/26/2006. The examiner answered by stating "that the arguments were not deemed persuasive to make the claimed invention overcome the prior art of record and place the application in condition for allowance."

(c)(v) (3) Summary of the Invention

The Appellant's invention pertains to a shade and rain umbrella combination. The basic umbrella, as shown in the drawings, consists of having a conventional shaft 2 and expanding ribs 10 at a top of the shaft 2. A shade cover 4 is placed over the ribs 10 and is fastened to the peripheral points of the ribs. The shade cover 4 consists of a woven mesh fabric for protection against ultraviolet rays of the sun (see page 2, line 12. However the mesh fabric allows for a ventilation by air (page 2, line 14) being able to pass through the mesh of the shade cover. This umbrella appears in many instances in sun-backed areas to protect against the UV rays of the sun. In case of rain a water proof cover 7 may immediately be placed over the shade cover. The rain cover may be placed over the shade cover 4 by way of fastening the peripheral points 9 of the rain cover to points of the ribs. The rain cover has substantially the same size as the shade cover (page 2, line 19) and is stored somewhere on the umbrella shaft when not in use (Fig. 3 at 20) or (Fig. 1 at 6).

(c)(vi) Grounds of Rejection to be reviewed on appeal

Claims 1 and 4 are rejected under 35 U.S.C 103(a) as being unpatentable over Johnson US Patent No. 5,487,401 in view of Bilotti US Patent No. 5,678,587 and in view of Kupferman US Patent No. 5,890,506. The examiner has to apply three references to make this rejection.

Claims 9 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson '401 in view of Kupferman '506 and Bilotti '587 as applied to claim 1 above and further in view of Allee US Patent No. 6,378,539. The examiner has to apply four references to make this rejection. The examiner was challenged in previous actions in the use of multiple references and she answered with a citation of *In re Gorman*, 933 F. 2d 982, USPQ 2d 1855 (Fed. Cir.1991). It may be that the references are in the same umbrella art but the cited references are quite different from what is

claimed.

(c)(vii)

Argument

with respect to the rejection of claims 1 - 4

The rejection of claims 1 and 4 cannot stand because the reference to Johnson is an entire different concept and construction. The reference to Johnson does not disclose the concept of a two mode use of an umbrella as is claimed by appellant, that is the use as sun shade umbrella and in a second mode the use as a rain umbrella. Johnson discloses a windproof umbrella that can only be used in one mode and that is if the umbrella, while in use, is subjected to high winds it is resistant to an inversion from high winds. This is the only purpose of the Johnson umbrella. The disclosed umbrella has a post to be grasped by a user and a plurality of ribs extending outwardly in a radial direction. A lower canopy is secured in a covering relation on the ribs. The lower canopy or cover includes a plurality of vent holes there through and a channel forming member secured to the lower canopy in surrounding relation to each lower vent hole. If this umbrella, so far described, would be used as a shade cover, as is claimed, it would be totally useless because of the vent holes 34 therein.

However, Johnson provides an additional stationary cover over the lower cover which may be fastened to the peripheral points of the ribs. In the Abstract it is expressly stated that the upper canopy has a dimension less than the lower canopy. This is contrary to what Appellant is claiming in claim 1. In addition, the upper canopy has openings 44 therein to let winds to pass there through.

The examiner states that "Johnson has a shade cover 20 over and supported by the ribs 18". The examiner continues to state that "the shade cover is made of a water resistant material with openings for allowing ventilation to pass there through". This is an incorrect interpretation of the Johnson reference.

If the rain cover is made of water proof material and there are openings therein, it is not a rain proof cover at all.

The examiner continues to state "that the rain cover 36 is placed over and connected to the shade cover by fastening means". This is incorrect. Appellants rain cover is not fastened to the shade cover but is fastened to the peripheral points 9 of the ribs 10. The examiner continues to state that "the rain cover 36 has a size that may be substantially the same as the shade cover. This is incorrect in that Johnson specifically states the upper canopy has a dimension less than that of the lower canopy (Abstract).

(c) (vii)

Argument

with respect to the rejection of claims 9 - 11 and 16

The examiner now introduces the Kupferman reference by admitting that the shade cover of Johnson is not defined as a fabric made of mesh material for protection against ultraviolet rays of the sun as is claimed. At this point in the discussion the Appellant wants to point out that at no time in the disclosure of Johnson there is any talk of a shade and a rain cover. The examiner derives these words from appellants disclosure. The Examiner continues to state that "Kupferman teaches a shade and rain umbrella combination comprising a rain cover 24, disposed on the shade cover 22, wherein the shade cover 22 having at least a portion 32 being made of woven mesh fabric for allowing ventilation air to pass there through and the rain cover 24 covering the mesh portion for preventing the rain into the mesh portion when used in raining". The examiner misinterprets this reference. There is never a mention of a shade cover and a rain cover. This umbrella is only used when it is raining and is designed to prevent an inversion of the umbrella in high winds just the same as the base reference to Johnson. The Examiner now suggests to modify the Johnson umbrella by incorporating the mesh fabric of Kupferman at least partially over into the shade cover 20 of Johnson. It is believed that the Johnson umbrella cannot be

modified in this manner, as is suggested by the Examiner. It is believed that this proposed modification would destroy the basic function and concept of the Johnson umbrella. This proposal is no indicia of obviousness and should not be made in rejecting claims.

The examiner now introduces the Bilotti reference to modify the Kupferman reference to provide the portion of the mesh material with a coat to prevent ultraviolet rays from the sun to the person carrying the umbrella. There is no need to make this modification because both umbrellas of Johnson and Bilotti do not use their umbrellas in a two mode fashion as is claimed by Appellant. They are simply rain umbrellas to prevent high winds from inverting the umbrellas. Since they are not used as shade umbrellas, by themselves, there is no use to convert any of them to protect against ultraviolet rays from the sun. None of the references to Johnson or Bilotti disclose that the rain covers may be kept separate, as is claimed in claim 1. Johnson does disclose in column 7, line 12, that the upper canopy 36 may be separated from the umbrella 10 so that it can be dried independently thereof. Thus, any water caught between the upper canopy and the lower canopy 20 may dry in a shorter period of time. This in no way suggests that the umbrella of Johnson may be used in a two-way mode as a separate shade cover and together as a rain cover. None of the references discloses a dual mode of use and that is, the use as a shade umbrella in one instance and the use as rain umbrella by using an additional cover in another instance when it rains, as is claimed.

(c)(viii)

Claims Appendix

1. A shade and rain umbrella combination including a basic umbrella having a shaft and expanding ribs at a top of said shaft, a shade cover placed over said ribs and fastened to a peripheral point at the end of said ribs, said shade cover consisting of a woven mesh fabric for protection against ultraviolet rays of the sun but at the same time allowing ventilation air to pass through said fabric, a separable water proof rain cover is placed over said shade cover in the event of rain, said rain cover is substantially the same size as said shade cover, means for fastening said rain cover to said peripheral point at each of the ends of said ribs, whereby said shade is used in sunshine and said rain cover is added in the event of rain but separate otherwise.

4. The umbrella combination of claim 1, wherein said means for fastening are flexible eyelets on said rain cover placed over each point at each end of said ribs.

9. The umbrella combination of claim 1 including means for clamping said shaft in an upright position on an object.

10. The umbrella combination of claim 9, wherein said means for clamping has a form of a C-shape clamp.

11. The umbrella combination of claim 10, wherein said C-shape clamp has means thereon for orienting and clamping said C-shape clamp in two different directions.

16. The umbrella combination of claim 1, wherein said shade cover is constructed of a knitted fabric including HDPE Polyethylene mono-tape.

(c)(ix)	<u>Evidence Appendix</u>	(none)
(c)(x)	<u>Related proceedings Appendix</u>	(none)

In view of all of the above the Board of Appeals is respectfully requested to consider the appellant's argument and reverse the examiner's position on unpatentability.


Werner H. Schroeder

Reg. No. 36,387

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